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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,980	02/16/2001	Anthony John Bell	5641C1-07-LAV	5253
29668	7590	03/24/2004	EXAMINER	
PFIZER, INC. 201 TABOR ROAD MORRIS PLAINS, NJ 07950			MADSEN, ROBERT A	
			ART UNIT	PAPER NUMBER
			1761	
DATE MAILED: 03/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/784,980	Applicant(s) BELL ET AL.	
	Examiner Robert Madsen	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 10-27 and 37-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,28-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Response filed December 19, 2003 has been entered. Claims 1-54 remain pending in the application. Claims 10-27 and 37-54 have been withdrawn from further consideration as being drawn to a non-elected invention.
2. The rejection of claims 1,2,4,6-9 made under 35 U.S.C. 102(e) as being clearly anticipated by Cherukuri et al. (US 6482465 B1) stands.
3. The rejection of claims 1, 2,4-9,28,29,31-36 made under 35 U.S.C. 102(b) as being clearly anticipated by Katsuragi et al. (EP 0732064 A1) stands.
4. The rejection of claims 3 and 30 made under 35 U.S.C. 103(a) as being unpatentable over Katsuragi et al. (EP 0732064 A1) in view of Raymont (AU 9671904 A) stands.
5. The rejection of claims 1,2,4,6-9, 28,29,,31,33-36 made under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (JP 09-103275) in view of Cherukuri et al. (US 6482465 B1) is hereby withdrawn.

Response to Arguments

6. Applicant's arguments filed December 19,2003 with respect to the rejection of claims 1,2,4,6-9, 28,29,,31,33-36 made under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (JP 09-103275) in view of Cherukuri et al. (US 6482465 B1) have been fully considered and are persuasive. The rejection has been withdrawn.
7. Applicant's arguments filed December 19,2003 have been fully considered but they are not persuasive with respect to the rejections made under 35 U.S.C 102(e) and

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102(b) as being anticipated by Katsuragi et al. and Cherukuri et al, respectively, as well as the rejection of claims 3 and 30 made under 35 U.S.C. 103(a) as being unpatentable over Katsuragi et al. (EP 0732064 A1) in view of Raymont (AU 9671904 A).

8. In response to applicant's argument (with respect to Cherukuri et al.) that the present invention is directed to a hard-boiled candy, the recitation "hard boiled candy" has not been given patentable weight because the recitation only occurs in the preamble (as stated in the Office Action mailed June 19, 2003). A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The composition as recited, and as evidenced by Cherukuri et al., reads on a chewy confection. The claims do not recite specific limitations /features/properties that exclude compositions other than hard-boiled candy compositions.

9. In response to applicant's argument that Cherukuri et al. fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a candy base composed of a mixture of sugar and other carbohydrate bulking agents kept in an amorphous or glassy condition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The mere recitation of "hard boiled candy" in the

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preamble, as discussed in the preceding paragraph, does not limit the scope of the claims to "a candy base composed of a mixture of sugar and other carbohydrate bulking agents kept in an amorphous or glassy condition".

10. In response to applicant's argument that Katsuragi et al. do not employ fats and oils with an amount of oil effective to suppress and unpleasant mouthfeel. However, Katsuragi et al. teach adding oils (i.e. Page 3, lines 9-13 and Page 3, line 58 to Page 4, line 5) at 0.01-10% of a confectionery base composition to mask the bitterness associated with a botanical (Page 4, lines 25-47). Therefore, Katsuragi et al. meets the compositional limitations recited in the claims, regardless of the intended purpose of the oil (i.e. masking bitterness or suppressing an unpleasant mouthfeel). Applicant is reminded that "[p]roducts of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

11. With respect to claims 3 and 30 rejected as obvious over the combination of Katsuragi et al. and Raymont. Katsuragi et al. teach the conventional hard candy with a botanical for the reasons cited in the preceding paragraph. Raymont is relied on as provides motivation and evidence for adding other conventional botanicals added to hard candies.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.


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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Madsen
Examiner
Art Unit 1761



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